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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,108	11/30/2001	Yoon Kean Wong	035451-0168 (3706.Palm)	4396
26371	7590	07/21/2005	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			PHAM, TITO QUANG	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,108

Applicant(s)

WONG ET AL.

Examiner

Tito Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/30/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference number 250. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied,

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such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the abstract, the words "disclosed" and "disclosure" on line 2, 3, and 7 should be removed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 4, 5, 8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Mittal.

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- In regarding to claim 1, Mittal shows a method of initial configuring of an electronic device for communication in a network (see figure 1), comprising: establishing a wireless communication link between first and second electronic devices (figure 1 server 28 and mobile station 12), the first device (server 28) contains a set of initial network parameters to enable communication between device and network; transmitting the network parameters to the second device (mobile station 12); retaining network parameters on the second electronic device (memory of mobile station 12); and establishing communication between the second device and the network utilizing the received network parameters setting (column 2 lines 43-56).
- Regarding claims 2 and 5, Mittal discloses the first device is configured to communicate and establishes a communication link with the network by using the network parameters (column 2 lines 60-65).
- Regarding claim 4, Mittal reveals the wireless communication between the two devices is a radio frequency (RF) link (column 2 lines 45-46).
- Regarding claim 8, figure 1 reveals a communication network with at least one wireless access point.
- Regarding claim 11, the same analysis above with respect to claim 1 is applicable. In figure 1, Mittal discloses a communication with at least one wireless access point.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 3, 4, 5, 8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayes, Jr. et al.

- In regarding to claim 1, Hayes, Jr. et al. shows a method of initial configuring of an electronic device for communication in a network (see figure 1, column 4 lines 58-63), comprising: establishing a wireless communication link between first and second electronic devices (column 4 lines 44-47), the first device (wireless programmer) contains a set of initial network parameters to enable communication between device and network; transmitting the network parameters to the second device (electronic device 100); retaining network parameters on the second electronic device (column 5 lines 3-6); and establishing communication between the second device and the network utilizing the received network parameters setting (column 3 lines 12-19).
- Regarding claims 2 and 5, it is inherent in Hayes, Jr. et al. that the network parameters are saved in the first electronic device (wireless

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programmer) and the electronic device (programmer) is a part of the communication network.

- Regarding claim 3, Hayes, Jr. et al. discloses the wireless communication link is an infrared link (column 5 lines 50-53).
- Regarding claim 4, Hayes, Jr. et al. reveals the wireless communication between the two devices is a radio frequency (RF) link (column 2 line 42).
- Regarding claim 8, figure 1 reveals a communication network with at least one wireless access point.
- Regarding claim 11, the same analysis above with respect to claim 1 is applicable. In figure 1, Hayes, Jr. et al. discloses a communication with at least one wireless access point.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 3, 6, 7, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mittal.
- Regarding claim 3, as previously stated in claim 1, Mittal discloses a method of configuring a device for communication with a communication network. Mittal does not disclose the wireless communications link is an infrared link. However, infrared (IR) is a well-known and well-used wireless protocol in the industry; therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to make a modification to include infrared for the short-range communication among electronic devices such as computer peripherals or PDAs.
 - Regarding to claims 6, 7, 14, 15, 16, and 19, Mittal shows a method of configuring a device for communication with a communication network. Mittal does not specifically state the electronic device is a handheld computer. However, in today technology, a "mobile station" device, as disclosed in Mittal, could be interpreted as the well-used personal digital assistant (PDA) which comprises components of a "handheld computer." Therefore, it would have been obvious to one of the

ordinary skill in the art at the time of the invention to use "handheld device/computer" as an electronic device in the network.

- Regarding to claims 9, 12, and 17, Mittal discloses a method of configuring a device for communication with a network. Mittal does not specify the wireless access point is a Bluetooth access point or Bluetooth transceiver. However, Bluetooth (short-range radio frequency) is another wireless protocol for short-range applications. Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to include Bluetooth for use among short-range devices.
- Regarding claims 10, 13, and 18, Mittal discloses a method of configuring a device for communication with a network. Mittal does not specifically mention IEEE 802.11 as the wireless link or transceiver. However, IEEE 802.11 or Wi-Fi is a widely accepted wireless networking standard. Thus, it would have been obvious to include IEEE 802.11 as another wireless protocol to use in the communication system.
- In claim 20 where two handheld computers are communicated with each other via an infrared link, analysis above regarding "handheld computer" and "infrared link" are applicable.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 6, 7, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes, Jr. et al..

- Regarding to claims 6, 7, 14, 15, 16, and 19, Hayes, Jr. et al. shows a method of configuring a device for communication with a communication network. Hayes, Jr. et al. does not specifically state the electronic device is a handheld computer. However, in today technology, a "wireless electronic" device, as disclosed in Hayes, Jr. et al., could be interpreted as the well-used personal digital assistant (PDA) which comprises components of a "handheld computer."

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use "handheld device/computer" as an electronic device in the network.

- Regarding to claims 9, 12, and 17, Hayes, Jr. et al. discloses a method of configuring a device for communication with a network. Hayes, Jr. et al. does not specify the wireless access point is a Bluetooth access point or Bluetooth transceiver. However, Bluetooth (short-range radio frequency) is another wireless protocol for short-range applications. Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to include Bluetooth for use among short-range devices.
- Regarding claims 10, 13, and 18, Hayes, Jr. et al. discloses a method of configuring a device for communication with a network. Hayes, Jr. et al. does not specifically mention IEEE 802.11 as the wireless link or transceiver. However, IEEE 802.11 or Wi-Fi is a widely accepted wireless networking standard. Thus, it would have been obvious to include IEEE 802.11 as another wireless protocol to use in the communication system.
- In claim 20 where two handheld computers are communicated with each other via an infrared link, analysis above regarding "handheld computer" and "infrared link" are applicable.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lewis discloses a wireless communication device containing a memory for receiving and storing initial configuration information.


Nangle shows RF programming of an electronic device (handheld) that contain non-volatile memory

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tito Pham whose telephone number is 571-272-8617. The examiner can normally be reached on 8-5 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2667 7/19/05